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09/865,572	05/29/2001	Tetsushi Nomoto	109452	3684

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EXAMINER

ADAMS, JONATHAN R

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/865,572

**Applicant(s)**

NOMOTO, TETSUSHI

**Examiner**

Jonathan R Adams

**Art Unit**

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10 and 12-17 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-10, 12, and 14-17 rejected under 35 U.S.C. 102(b) as being anticipated by “Windows 98 Professional Reference” (hereafter referred to as WPR).

As to claim(s) 1, 8, 12:

WPR teaches features of the Windows 98 operating system comprising:

- Transmitting/Receiving digital image data from computer to printing device along with data for location of image in computer / Adding transmitted information to the print / By default, the URL and the current date are in the print footer (Page 16, “Print Hard Copy of a Web Page”, WPR)
- Printing transmitted digital image data at printing device / Print Hard Copy of a Web Page (Page 16, “Print Hard Copy of a Web Page”, WPR)

3. As to claim(s) 2, 9, 10:

Computer includes a storage file system with directory information and wherein information includes specific directory information related to the digital image data /

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FAT, a method for storing files and file directories on a hard disk (Chapter 17, Page 4, Line 4, WPR)

4. As to claim(s) 3:

The computer is of a customer making an order, print device makes print in response to the order of the computer / Print Hard Copy of a Web Page (Page 16, "Print Hard Copy of a Web Page", WPR)

Delivering the print to the customer / All printing devices deliver a printed copy to the operator, such as through the use of a printer out-feed tray.

5. As to claim(s) 4:

Digital image data are transmitted from computer to print device through telecommunications system / Network printers (Ch 13, Page 2, Line 26, WPR)

6. As to claim(s) 7, 14:

Storing digital image data at a location of a first database in the computer / Designating the location of the digital image data / Each files entry in the FAT directory points to the first cluster used (Ch 17, Page 5, Line 1, WPR)

Recording in second database change in location of digital image data in first database / Two identical copies of FAT (Ch 17, Page 4, Line 7, WPR)

Consulting second database to determine current location of database / Two copies of FAT are stored incase one is damaged (Ch 17, Page 4, Line 9, WPR)

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Located digital image data and current location are transmitted / By default, the URL and the current date are in the print footer (Page 16, "Print Hard Copy of a Web Page", WPR)

7. As to claim 15, 17:

Trying to locate the digital data in the first database / FAT, a method for storing files and file directories on a hard disk (Chapter 17, Page 4, Line 4, WPR). When printing a document the document data must always first be located.

Consulting/locating data after failure to locate data because of a change in location in first database / Two copies of FAT are stored incase one is damaged (Ch 17, Page 4, Line 9, WPR)

8. As to claim 16:

Digital data is digital image data / Stored .JPG files (Chap 17, Page 18, Line 5, WPR)

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 5 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over WPR in view of Grabber et al., US Pregrant Pub No 20020165911 (hereafter referred to as '911).

As to claim(s) 5, 13:

11. WPR teaches printing image data on a network printer including the directory location of the file as a footer. WPR does not teach using hashing function to encrypt the file location for the location information added to the print. '911 teaches using a hashing function to encrypt file name URLs (Page 3, Paragraph 0027, '911) for reference. It would have been obvious to a person of ordinary skill in the art at the time of invention to use hashing of file name URLs as in '911 for the printed footers in the invention of WPR. One of ordinary skill in the art would have been motivated to use hashing of file name URLs as in '911 for the printed footers in the invention of WPR because using hashed file identifiers can improve performance.

### ***Allowable Subject Matter***

12. Claim 6 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 11 is allowed. The following is an examiner's statement of reasons for allowance: the described invention including the steps of sending encrypted image data

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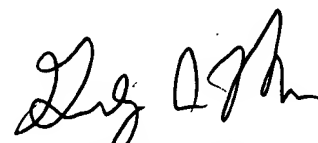
to a network printer, decrypting image data at the printer, adding encrypted image data to the print, and sending decrypted image data back to the original sender is considered to be novel.

14. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan R Adams whose telephone number is (571)272-3832. The examiner can normally be reached on Monday – Friday from 10am to 6pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (571)272-3838. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



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